

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111  
Serial Number: 09/846,857  
Filing Date: May 1, 2001  
Title: HIGH SPEED PROGRAMMABLE COUNTER

Page 9  
Dkt: 303.024US4

### **REMARKS**

This is in response to the Office Action mailed on November 19, 2004, and the references cited therewith. In response to this Office Action, independent claims 10, 18 and 22 have been amended. As a result, claims 10-36 are still pending in this application. Reconsideration of the claims is respectfully solicited.

#### **Double Patenting Rejection**

Claims 10, 11, and 18 were rejected under the judicially created doctrine of double patenting over claims 1 and 3 of U.S. Patent No. 6,226,295. Applicant has attached a Terminal Disclaimer thereby overcoming this rejection.

#### **§102 Rejection of the Claims**

Claims 10-13, 18, and 22 were rejected under 35 U.S.C. § 102(e) as being anticipated by Thomman et al. (U.S. Patent No. 5,719,890). The inventors in the patent to Thomman et al. were all under a duty to assign their patent rights at the time of their invention to the same assignee as did the inventors of the present patent application. Also, the Thomman et al. patent is a removable reference under 35 U.S.C. § 102(e). Applicant respectfully reserves the right to swear behind the Thomman et al. patent at a later date, however, Applicant chooses to distinguish the Thomman et al. patent at this time.

Independent apparatus claims 10, 18 and 22 have been amended to include limitations not found in the Thomman et al. patent. In particular, these claim have been amended to include the limitations that the programmable counter counts the start value up to the maximum count value and then rolls the counter over to zero again. The counter does not stop until it hits the stop value. Thus, the counter rolls over to zero after reaching a maximum value and continues continuing until it reaches the indicated stop count. In this manner, the start count value may actually be higher than the stop count because the counter will just roll over and begin counting at 0 until it reached the stop count. This limitation of rolling the counter over is not found anywhere in the Thomman et al. patent.

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Page 30  
Dkt: 303.024US8

Since all of the elements of the claims are not found in the Thomman et al. patent, the rejection of claims 10, 18 and 22, and the claims that depend upon claim 10, is no longer valid. Reconsideration of claims 10-13, 18, and 22, reconsideration of the rejections and an indication of allowance of all claims is respectfully solicited.

Allowable Subject Matter

Applicant acknowledges the allowance of claims 14-17, 19-21, and 23-26.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6904 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date Feb 22, 2005

By

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I hereby certify that this paper is being transmitted by facsimile to the U.S. Patent and Trademark Office on February 22, 2005.

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